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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,451	12/31/2003	Ross Koningstein	Google-41 (GP-099-00-US)	4989
82402	7590	06/09/2010	EXAMINER	
Straub & Pokotylo 788 Shrewsbury Avenue Tinton Falls, NJ 07724			BEKERMANN, MICHAEL	
			ART UNIT	PAPER NUMBER
			3622	
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			06/09/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/750,451	<b>Applicant(s)</b> KONINGSTEIN ET AL.	
	<b>Examiner</b> MICHAEL BEKERMAN	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-15,18-39,42,43,46-56,59-84 and 86-88 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-15,18-39,42,43,46-56,59-84 and 86-88 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :3/19/08 6/11/08 10/31/08 5/8/09 7/28/09 12/29/09 5/5/10.

## DETAILED ACTION

This action is responsive to papers filed on 2/9/2009.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. **Claims 1, 6-10, 14, 19-23, 27, 30, 32-36, 42, 47-51, 55, 60-64, 69, 71, 73-77, 81-84, and 86-88 are rejected under 35 U.S.C. 102(e) as being anticipated by Paine (U.S. Pub. No. 2003/0055816).** Paine shows a method and apparatus for recommending search terms to an advertiser that includes all of the limitations recited in the above claims.

**Regarding claims 1, 14, 27, 42, 55, 68, 81-84, and 86-88,** Paine teaches accepting a category (initial search term entered by advertiser), looking up one or more keywords based on a previously stored association of a plurality of keywords and categories (related search terms, thesaurus, and string matching algorithm), displaying the keywords to the advertiser and receiving advertiser input in response to the suggestion, determining whether to store at least some of the keywords as ad targeting

keywords based on the advertiser input (add bidded search term) (Paragraphs 0073, 0086, 0107, and 0111), and serving an advertisement for presentation to a user using the ad targeting keywords (Paragraph 0040). Paine further discloses accepting ad information, and determining a category from the ad information (Abstract, Sentences 1-3).

**Regarding claims 6, 19, 32, 47, 60, and 73**, Paine teaches the performing of qualification testing of the determined one or more keywords to determine if a keyword is qualified or unqualified for use as an ad targeting keyword and the providing of those qualified keywords as ad targeting keywords (Paragraphs 0115-0116).

**Regarding claims 7-10, 20-23, 33-36, 48-51, 61-64, and 74-77**, Paine teaches the tracking of the performance of all ads served using an ad targeting keyword. Paine's tracking is performed in general as well as across specific categories, including the accepted category and advertiser search listing (Paragraphs 0087-0088).

**Regarding claims 30 and 71**, Paine teaches advertisements as having ad creative information for rendering the ad (different descriptions) and a landing webpage linked from the advertisement (Figure 7). Paine further teaches using information from the advertiser webpage to determine ad creative information (Abstract).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3622

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**2. Claims 2, 11, 15, 24, 28, 29, 37, 43, 52, 56, 65, 69, 70, and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paine (U.S. Pub. No. 2003/0055816).**

**Regarding claims 2, 15, 28, 43, 56, and 69,** Paine's invention doesn't appear to specify a tool that keeps track of negative ad targeting keywords. Paine does teach that it is well known to have a tool to keep track of two lists, a list of good words for an advertiser's site and a list of negative keywords having no relation to the advertisers site or content (Paragraph 0008). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include negative keywords into the system of Paine. This would allow more accuracy in relation to relevant keywords.

**Regarding claims 29 and 70,** Paine teaches advertisements as having ad creative information for rendering the ad (different descriptions) and a landing webpage linked from the advertisement (Figure 7). Paine further teaches using information from the advertiser webpage to determine ad creative information (Abstract). Paine does not appear to specify using information from the advertisement to determine a category. However, since Paine shows the advertisements as being html-based text ads (Figure 7) and Paine discloses determining ads based on webpages (webpages being based on html) (Abstract), the technology to read advertisement content to determine categories is present in Paine. It would have been obvious to one having ordinary skill in the art at the time the invention was made to determine category information from the advertisement itself to better target the ad and determine more relevant keywords.

**Regarding claims 11, 24, 37, 52, 65, and 78**, Paine teaches a system for recommending ad targeting keywords for ads displayed on a search site. Paine doesn't appear to go into detail about the type of space that will be used for the ad on the search site. While it may not be inherent, common sense dictates that when a new advertisement is added to a search page, it should be added to an ad spot that would otherwise be unused, or the 2 advertisements would overlap and some data would be obstructed from view. It would have been obvious to one having ordinary skill in the art at the time the invention was made to specify an advertisement as being served on a portion of the webpage that would otherwise be unused. This would keep the operator of the search site from overlapping other information with an advertisement.

3. **Claims 5, 18, 31, 46, 59, and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paine (U.S. Pub. No. 2003/0055816) in view of Bourdoncle (U.S. Pub No. 2002/0052894).**

**Regarding claims 5, 18, 31, 46, 59, and 72**, Paine teaches recommending keywords based on numerous methods including a thesaurus database. While it could be argued that a thesaurus database would have to implement an index using a lookup key according to the well-known functionality of thesauruses (looking up words using other words as lookup keys), it could also be argued that such a teaching does not appear to be specified by Paine. However, Bourdoncle teaches an example of an index in which one type of information is used to locate another type of information (Claims 28 and 30). It would have been obvious to one having ordinary skill in the art at the time

Art Unit: 3622

the invention was made to use an index (much like one implemented in a common thesaurus, and like the one taught by Bourdoncle) to correlate the categories and keywords of Paine. Such a method will allow for speedy lookup times.

**4. Claims 12, 13, 25, 26, 38, 39, 53, 54, 66, 67, 79, and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paine (U.S. Pub. No. 2003/0055816) in view of Giacalone (U.S. Pub No. 2001/0052000).**

**Regarding claims 12, 13, 25, 26, 38, 39, 53, 54, 66, 67, 79, and 80,** Paine does not appear to specify storing keywords in a specific order to present to an advertiser based on inventory criteria. However, attempting to market certain items ahead of other items because that first item has a larger inventory that needs to be sold is an old and well-known concept. While Paine teaches selling an inventory of ad spots according to keyword (Paragraph 0075), Giacalone teaches a system and method in which advertisements for clothing that have the highest inventory are shown more , and when another clothing item attains the highest inventory, that item will then be advertised above the others (Paragraph 0027). It would have been obvious to one having ordinary skill in the art at the time the invention was made to store, present, and advertise keywords to advertisers based on the number of ad slots in inventory for each keyword. Giacalone discloses that by advertising high-inventory items, more sales will occur for those items (Paragraph 0027).



***Response to Arguments***

5. Applicant's arguments are believed to be addressed by the amended rejections above.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MICHAEL BEKERMAN** whose telephone number is (571)272-3256. The examiner can normally be reached on Monday - Thursday, 9:00 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael Bekerman/  
Primary Examiner, Art Unit 3622